



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,581	10/07/2005	Steven Bates	2543-1-045PCT/US	5079

23565 7590 08/08/2006

KLAUBER & JACKSON
411 HACKENSACK AVENUE
HACKENSACK, NJ 07601

EXAMINER

SHEN, BIN

ART UNIT	PAPER NUMBER
----------	--------------

1655

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/537,581

Applicant(s)

BATES, STEVEN

Examiner

Bin Shen

Art Unit

1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 14-22 is/are pending in the application.
4a) Of the above claim(s) 4-11 and 14-22 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-3 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

Art Unit: 1655

DETAILED ACTION

Election

Applicant's election with traverse of Group I, claims 1-3, in the reply filed on 6/21/2006 is acknowledged. The traversal is on the ground(s) that the Groups are not "independent" and "distinct", and there is no search burden. This is not found persuasive because the arguments ("independent", "distinct", "search burden") are not applicable to lack of unity restriction rules (PCT Rule 13.1).

The requirement is still deemed proper and is therefore made FINAL.

The IDS received 9/1/2005, the preliminary amendment received 6/6/2005 have been entered.

Claims 4-11 and 14-22 are nonelected thus are withdrawn from further consideration.

Only claims 1-3 are presented for examination on the merits.

Specification

1. The abstract of the disclosure is objected to because the abstract must be a single paragraph. Correction is required. See MPEP § 608.01(b). A new abstract on a separate page is required to replace the abstract submitted which is the first page of the WO document of the application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1655

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Belford et al. (J. Biol. Chem. 1993;268:2444-2450).

Belford et al. teach a method of determining the interaction (activity) of a fungal tRNA ligase enzyme (TRL1) with compounds. Fungal TRL1 is provided as a fusion protein between a full-length yeast tRNA ligase with the carboxyl terminus of the *E. coli* DHFR (page 2445, left column, 3rd full paragraph), candidate compounds are nucleoside triphosphate (NTP: ATP, CTP, GTP, or UTP) TRL1 is incubated with the compounds and interaction of the compounds with TRL1 is determined by splicing reactions (page 2445, right column, 5th full paragraph, and also see specification at the bottom of page 10).

Therefore, the cited reference is deemed to anticipate the instant claims above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Art Unit: 1655

3. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Belford et al. and Baymiller et al. (Gene 1994;142:129-134), in view of Spaltmann et al. (Drug Discovery Today 1999;4:17-26).

Belford teaches what is above.

Belford does not teach that the TRL1 is from fungus of *Candida* or *Aspergillus* species.

Baymiller teaches the isolation and sequence of the tRNA ligase-encoding gene of *Candida albicans*, and suggests that this enzyme provide a good target for antifungal drug search (see title and page 130, left column, end of 1st full paragraph).

Spaltmann teaches that *Candida albicans* is a major human pathogenic fungi (see abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the TRL1 from fungus of *Candida* as taught by Baymiller in the method of Belford to screen for candidate antifungal compounds that impair TRL1 function because Spaltmann teaches that *Candida albicans* is a major human pathogenic fungi (see abstract). One would have been motivated to make the modification because Belford specifically described the method used to determine the function of TRL1 and Baymiller suggest that *Candida* TRL1 provides a good target for antifungal drug search (see title and page 130, left column, end of 1st full paragraph), and would reasonably have expected success in view of Belford and Baymiller's teaching because both methods use fungal TRL1.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to

Art Unit: 1655

one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Conclusion

4. No claim is allowed.

Certain papers related to this application may be submitted to Art Unit 1636 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone number for the Group is 571-273-8300. NOTE: If Applicant does submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business


Art Unit: 1655

days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Any inquiry concerning rejections or objections in this communication or earlier communications from the examiner should be directed to Bin Shen, Ph.D., whose telephone number is (571) 272-9040. The examiner can normally be reached on Monday through Friday, from about 9:00 AM to about 5:30 PM. A phone message left at this number will be responded to as soon as possible (i.e., shortly after the examiner returns to her office).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Terry McKelvey can be reached at (571) 272-0775.



MICHAEL MELLER
PRIMARY EXAMINER

B Shen

Art Unit 1655